

REMARKS

Applicant requests reconsideration and allowance of the subject patent application in light of the changes above and the remarks that follow.¹ Claims 1-13 are pending. By this Amendment, claims 1-10, 12 and 13 have been amended to correct technical issues and clarify the recited subject matter.

Applicant traverses the rejection of claims 1-13 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. The Examiner asserts Applicant's specification does not satisfy the requirements of Section 112 because the specification does not explain "how the short term and long term predictions are calculated to determine the quality of the wireless connection; lacks how the parameters for the WAP are determine[d] based on the predictions; also lacks how the short and long predictions are related to set up the wireless connections." (Office Action, p. 2.) Applicant respectfully disagrees.

The enablement requirement refers to the requirement of 35 U.S.C. §112, first paragraph, that the specification describe how to make and how to use the invention being claimed. The Supreme Court decision *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) set forth the test for enablement as: "Is the experimentation needed to practice the invention undue or unreasonable?" *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) confirms this is still the standard. See also MPEP 2164.01. As identified in MPEP 2164.01(a) the undue experimentation factors include, but are not limited to:

- (a) the breadth of the claims;
- (b) the nature of the invention;
- (c) the state of the prior art;
- (d) the level of one of ordinary skill;
- (e) the level of predictability in the art;
- (f) the amount of direction provided by the inventor;

¹ The Office Action contains statements characterizing the claims and related art. Regardless of whether any such statements are specifically addressed herein, Applicant's silence as to these characterizations should not be construed as acceptance of them.

- (g) the existence of working examples; and
- (h) the quality of experimentation used to make and use the invention based on the content of the disclosure.

None of these factors have been addressed by the Examiner. Insofar as the initial burden rests on the Examiner to provide reasons for lack of enablement, and the Examiner has provided no explanation regarding any of these factors, it is respectfully submitted that this rejection must fail, as the record does not establish a *prima facie* case of unpatentability. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Thus, Applicant requests that the rejection of claims 1-13 under Section 112, first paragraph be withdrawn.

Additionally, as noted in MPEP 2164.01(a), a conclusion of lack of enablement means that, based on the evidence regarding each of the above factors of the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. It is not evident that any undue experimentation need be done to carry out the claimed invention. As such, Applicant respectfully requests that the rejection of claims 1-13 under Section 112, first paragraph be withdrawn for this reason as well.

Claims 1-13 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner asserts that claims 1-10 do not positively recite a method and that claim 11-13 are hybrid claims. (Office Action, p. 2.) In addition, the Examiner alleges that claims 2-7 lack antecedent basis for the recited "predication." (*Id.* at p. 3.)

Applicant has clarified the pending claims to address the issues raised by the Examiner. It is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 1-13 under Section 112, second paragraph.

Conclusion

For the reasons set forth above, Applicant respectfully requests allowance of claims 1-13.

If additional fees are required, please charge Deposit Account No. 02-4800 the necessary amount.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: August 6, 2008

By: /Steven Ashburn/
Steven Ashburn
Registration No. 56,636

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620